

### **REMARKS**

Claims 1-10 are pending and under consideration in the above-identified application, claims 11-41 stand withdrawn pursuant to a restriction requirement.

In the Office Action dated November 8, 2011, claims 1-10 were rejected.

With this Amendment, claims 1, 3, 4, 6, 8 and 10 were amended and claim 2 was cancelled. No new matter has been added as a result of the amendment.

#### **I. 35 U.S.C. § 103 Obviousness Rejection of Claims**

Claims 1-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Koga et al. (U.S. Publication No. 2003 0032697) in view of Arita et al. (U.S. Publication No. 2003 0107632) and Ouchi et al. (U.S. Publication No. 2001 00451175). Applicant respectfully traverses this rejection.

Independent claim 1 requires, among other things, an ink that has a polyhydric alcohol including a hydrocarbon group with the number of carbon atoms less than 9, the polyhydric alcohol having an (I/O) of the inorganic value to the organic value not less than 1.18 and not more than 2.5.

Koga et al. does not teach or even fairly suggest a polyhydric alcohol having an (I/O) of the inorganic value to the organic value not less than 1.18 and not more than 2.5 as required by the claims. The Examiner states that, “while the inorganic ratio to organic value ratio is not explicitly recited, the values for the species specified as suitable by the reference are seen as meeting those instantly claimed.” Office Action, page 2. Applicant disagrees. The Examiner points to no where in Koga et al. where the claimed requirement is even fairly suggested and as admitted by the Examiner, Koga et al. does not disclose the inorganic ratio to organic ratio. At best, the Examiner argument appears to be based on impermissible hindsight. *Hodosh v. Block*

*Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). Further, this deficiency is not cured by either Arita et al. or Ouchi et al. Accordingly, claim 1 is patentable over the above cited references, taken either singularly or in combination with each other as are dependent claims 3-10 for at least the same reasons. As such, Applicant respectfully requests that the rejection of claims 1 and 3-10 be withdrawn.

## **II. Conclusion**

In view of the above amendments and remarks, Applicant submits that all claims are clearly allowable over the cited prior art, and respectfully requests early and favorable notification to that effect.

Respectfully submitted,

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By: /Anne K.W. Sutton/  
Anne K.W. Sutton  
Registration No. 59,592  
SNR DENTON US LLP  
P.O. Box 061080  
Wacker Drive Station, Willis Tower  
Chicago, Illinois 60606-1080  
(312) 876-8000